

## **REMARKS**

Reconsideration is respectfully requested for Claims 17-21 and 23-26, said claims having been rejected under 35 USC 103 based upon varying combinations of four United States patents, viz, U.S. Patent No. 5,906,371 to Peterson; U.S. Patent No. 5,660,389 to Freda, III; U.S. Patent No. 6,120,300 to Ho, et al; U.S. Patent No. 5,921,864 to Walker, et al, and with various of such U.S. patents being applied in view of the Links 386 CD Players Manual and Milton Bradley's GO TO THE HEAD OF THE CLASS <sup>TM</sup>. These rejections are respectfully traversed.

Regarding the Examiner's response to Applicants' arguments filed September 16, 2003, Applicants respectfully disagree with the Examiner's allegation of acquiescence to the Examiner's previous objection by virtue of not responding specifically to each rejection. The Applicants respectfully submit that the previous amendment filed September 16, 2003 was intended to narrow the issues in contemplation of a possible appeal. This narrowing of issues was intended to limit Claims 17 and 21 in order to disclose a feature that is novel and is not taught, disclosed nor suggested in any cited patent or reference. In no way were the Applicants acquiescing to the Examiner's other rejections.

To overcome the Examiner's rejections, the Applicants had amended Claims 17 and 21, filed on September 16, 2003, to include the limitation "allowing the game piece of said given player to remain in said predetermined location only if the answer to the random question is correct." In turn, the Examiner relies on Peterson (U.S. 5,906,371) at Column 1, Lines 49-51 alleging that Peterson discloses Milton Bradley's GO TO THE HEAD OF THE CLASS <sup>TM</sup>. Applicants respectfully submit that the Peterson reference does nothing other than simply mention the name GO TO THE HEAD OF THE CLASS <sup>TM</sup>. Specifically, Peterson at Column 1, Lines 48-51 states: "Similarly, the prior art also includes such board games as 'SCRABBLE', 'JUNIOR TRIVIA' and 'GO TO THE HEAD OF THE CLASS'

(trademarks of the Milton Bradley company)."

The Examiner further alleges that he does not rely upon the instructions to GO TO THE HEAD OF THE CLASS <sup>TM</sup>. In the present Office action, dated December 10, 2003, the Examiner alleges that "[t]he prior art of record, Peterson, discloses this feature and therefore the Examiner believes the claims of the instant invention are rendered obvious over the prior art." However the internet article, which was attached via PTO form 892 to the present Office Action, is clearly relied upon as part of the allegation that the Applicants' feature of "allowing the game piece of said given player to remain in said predetermined location only if the answer to said random question is correct," is disclosed. The Examiner further alleges that GO TO THE HEAD OF THE CLASS <sup>TM</sup> discloses "if a player lands on a desk with a 'homework' assignment (questions/answer) and answers the question incorrectly (has a poor grade), then the player is sent back."

Applicants respectfully point out that the Examiner's cited art GO TO THE HEAD OF THE CLASS rules (online) (cited as part of paper No. 11; form PTO-892) specifically states, under the heading Homework Desks: "Some desks are marked 'Homework'.

Whenever a player lands on a Homework space they must immediately roll any one die. The roll determines the player's 'grade' for the homework (A+ down to D). Look at the Homework charts on the blackboards to see how many spaces the player's piece must move and then do so."

Thus, Applicants respectfully submit that by virtue of landing on a "Homework" desk, there is no question or answer associated with the Homework desk or in the movement of the player's piece. The movement of the players piece is clearly based on the determination of a "grade" based on the roll of a die. Therefore, Milton Bradley's GO TO THE HEAD OF THE CLASS <sup>TM</sup> game does not in any way teach, disclose, nor even suggest the Applicants' novel feature of allowing the game piece to remain in a predetermined location only if the answer to

a random question is correct.

The Examiner has relied upon new cited art as a basis for this rejection. The Peterson reference, by itself, does not disclose any rules or details of GO TO THE HEAD OF THE CLASS <sup>TM</sup> and as such Peterson cannot be relied upon to reject Applicants' claim element of "allowing the game piece of said given player to remain in said predetermined location only if the answer to the random question is correct."

Applicants appreciate the Examiner's withdrawal of the rejections of Claims 17-21 and 23-26 under 35 USC 112, second paragraph, based on Applicants' response filed September 16, 2003. It is still respectfully believed that the Applicants' novel feature of allowing a game piece to remain in a predetermined location only if the answer to the random question is correct, is indeed a novel feature and therefore it is respectfully submitted that Claims 17-21 and 23-27 are patentable over the cited art and a favorable condition of such claims is respectfully requested.

#### **OTHER AMENDMENTS**

Claim 25 was amended to add the word "and" after the word "listing;" to remove the ";" after the word "ages", and to add a "." after the word "ages". Applicants respectfully submit that these were corrections of typographical errors only and not an attempt to introduce new matter. Applicants respectfully ask that these amendments be entered.

#### **CONCLUSION**

It is therefore submitted that this application, with its Claims 17-21 and 23-27, is in prima facie condition for allowance. Accordingly the Applicants courteously solicit the advancement of the application to issue. The Applicants are of the opinion that the correct fees, with respect to the filing of this response, have been included herein. However, if additional fees are required, the Commissioner is hereby respectfully authorized to deduct such fees from Deposit Account Number 13-2166.

Date 5-10-04

Respectfully Submitted,



Taras P. Bemko.

Registration No. 52,609

THE MATTHEWS FIRM (Customer #0218987)

1900 West Loop, Suite 1800

Houston, Texas 77027

(713) 355-4200 - Telephone

(713) 355-9689 - Telecopier